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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,658	12/01/2000	Davor Runje	PM3	S970

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EXAMINER

POLTORAK, PIOTR

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,658

Applicant(s)

RUNJE ET AL.

Examiner

Peter Poltorak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment, and remarks therein, received on 11/17/2004 have been entered and carefully considered.
2. The Amendment introduces no new limitations.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Response to Amendment

4. Referring to paragraph 2 (the examiner believes that the applicant intended to address paragraph 3, wherein the new oath or declaration had been required) of the Office Action, applicant requested additional time to obtain signatures from all of the applicants. The request has been noted.
5. Applicant's arguments have been carefully considered but they were not found persuasive.
6. As per claims 1-4, 6, 8, 11-13, 15, 17 and 19 applicant argues that a cryptographic program key is not a license and as a result *Spies et al.* does not teach downloading of licensing information. In addition, as a result of license not being shown applicant traverses rejections of claims 5, 7, 9-10, 14, 16, 18 and 20.
7. The argument is not persuasive: the examiner points out that no definition of license is provided in the application, and the examiner chose the broadest reasonable interpretation.

Spies et al. teaches secure purchase and delivery of video content programs over various distribution media, wherein the content must be decrypted prior to replay

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(col.2 lines 26-31). As a result the cryptographic program key that permits decrypting the content, reads on the Webster's definition that applicant included in applicant's remarks.

8. Claims 9 and 18 are directed towards a memorizing means incorporated in the playback means for memorizing experienced but unlicensed content for future license. In the Office Action the examiner cited obviousness statement over *Spies et al.* in view of *Yu*.

Spies et al. teach a device with playback means (DVD player, computer or other computing device etc., e.g. col. 6 lines 31-33), and the examiner cited *Yu* who teaches desirability of preventing unnecessary traffic, which reads on desirability of storing content (license and unlicensed) in a device comprising the playback means. Applicant argues that the rejection over *Spies et al.* in view of *Yu* due to the fact that *Yu* does not provide the teaching on "how to do it".

However, memorizing means to memorize content with playback means is well known in the art (in personal computers for example), and it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to extend the memorizing means to experienced but unlicensed content in order to prevent traffic bottleneck as taught by *Yu*.

9. Claims 1-4, 6, 8, 11-13,15, 17 and 19 remain rejected under 35 U.S.C. 102(e) as being anticipated by *Spies et al.* (U.S. Patent No. 6,055,314) for the reason discussed in the previous Office Action.

10. Claims 5, 7, 10 and 14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over *Spies et al.* (U.S. Patent No. 6,055,314) for the reason discussed in the previous Office Action.
11. Claim 16 remains rejected under 35 U.S.C. 103(a) as being unpatentable over *Spies et al.*, as applied to claim 15 above, in view of *Hurtado et al.* (U.S. Patents No. 6, 418,421) for the reason discussed in the previous Office Action..
12. Claims 9 and 18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over *Spies et al.*, as applied to claim 15 above, in view of *Yu* (Networked Electronic Video Distribution) for the reason discussed in the previous Office Action..
13. Claim 20 remains rejected under 35 U.S.C. 103(a) as being unpatentable over *Spies et al.*, as applied to claim 15 above, in view of *Amazon.com* (<http://web.archive.org/web/19991013091817/http://amazon.com/>) for the reason discussed in the previous Office Action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571)272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571)272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jan
3/13/05

Greg Morse

GREGORY MORSE
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